

REMARKS

Claims 1, 5, 11, and 16 are amended. Claims 4, 6-10, 14-15, and 19-20 are canceled without prejudice or disclaimer. No new matter is added by these amendments. By amending and canceling the claims, applicant is not conceding that the claims are unpatentable over the references cited by the Office Action and is not conceding that the claims are non-statutory under 35 U.S.C. 101, 112, and 103, as the claim amendments are only for the purpose of facilitating expeditious prosecution. Applicant respectfully reserves the right to pursue the subject matter of the claims as it existed prior to any amendment or cancellation in one or more continuation and/or divisional applications. Claims 1-3, 5, 11-13, and 16-18 are pending. Applicant respectfully requests reconsideration and allowance of all claims in view of the amendments above and the remarks that follow.

35 U.S.C. 101 Rejections

Claims 6-10 are rejected under 35 U.S.C. 101 because "the claimed invention is directed to non-statutory subject matter." Claims 6-10 are canceled without prejudice or disclaimer, so the rejections are moot.

35 U.S.C. 112 Rejections

Claims 1-10 are rejected under 35 U.S.C. 112 as indefinite. Claim 1 is amended to provide antecedent basis for "the e-mail address." Claims 2 and 3 are definite for depending on claim 1. Claims 4 and 6-10 are canceled without prejudice or disclaimer, so the rejections are moot.

35 U.S.C. 103 Rejections

Claims 1-2, 6-7, and 11-12 are rejected under 35 U.S.C. 103(a) as unpatentable over Itoh (U.S. Patent Publication 2002/0107930) in view of Schoeffler (US Patent

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Publication 2001/0049745). Claims 3, 8, and 11 are rejected under 35 U.S.C. 103(a) as unpatentable over Itoh in view of Schoeffler and Harris (US Patent Publication 2003/0229632). Claims 4, 9, and 14 are rejected under 35 U.S.C. 103(a) as unpatentable over Itoh in view of Schoeffler and Brookner (US Patent 6,897,973). Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as unpatentable over Itoh in view of Schoeffler and Maxwell (US Patent 5,805,810). Claim 15 is rejected under 35 U.S.C. 103(a) as unpatentable over Itoh, Schoeffler, Brookner, and Maxwell. Claims 16-17 are rejected under 35 U.S.C. 103(a) as unpatentable over Itoh, Schoeffler, and Maxwell. Claim 18 is rejected under 35 U.S.C. 103(a) as unpatentable over Itoh, Schoeffler, Maxwell, and Harris. Claims 19-20 are rejected under 35 U.S.C. 103(a) as unpatentable over Itoh, Schoeffler, Maxwell, and Brookner. Applicant respectfully submits that the claims are patentable over Itoh, Schoeffler, Harris, Maxwell, and Brookner because Itoh, Schoeffler, Harris, Maxwell, and Brookner do not teach or suggest all of the claim elements for the reasons argued below.

Claim 1 recites: "determining whether the recipient identifier in the e-mail that identifies the intended recipient of the e-mail comprises an e-mail address; in response to the determining, if the recipient identifier in the e-mail that identifies the intended recipient of the e-mail does not comprises the e-mail address, removing the recipient identifier from the e-mail, printing the e-mail, printing postage on an envelope, printing a street address associated with the recipient identifier on the envelope, and subtracting a cost of the postage from an account associated with an originator of the e-mail" which is not taught or suggested by Itoh, Schoeffler, Harris, Maxwell, and Brookner for the reasons argued below.

In contrast to claim 1, when the Itoh user (at [0080]) selects the "recipient deletion button 132" and "input[s] an operation symbol '-' to subtract or remove one destination from ... a group name," the Itoh user is "subtract[ing] or remov[ing]" a "destination" that the user wants to prevent from receiving an electronic mail message. Thus, the Itoh "subtract[ed] destination" does not teach or suggest, and in fact teaches away from, the "recipient identifier .. that identifies the intended recipient" in claim 1

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because the Itoh user intends the “subtract[ed] destination” to not receive the contents of the Itoh electronic mail message.

The fact that the Itoh user does not want the “subtract[ed] destination” to receive the contents of the electronic mail message can be further seen in Itoh at [0013] and [0014], which recites: “a mail server in the network may be provided with an address book in which a group name representing mail addresses of all members of the group including a user concerned is registered, and if the user specifies the group name as a destination, a user's electronic mail message is also transmitted to the user him/herself. In order to solve the above problems ...” Thus, Itoh attempts to solve the problem of a user receiving the user's own sent electronic mail messages when the sending user is specified in the group to which the electronic mail messages are sent by removing the user from the group.

Further, hypothetically modifying Itoh to “[print] the e-mail, [print] postage on an envelope, [print] a street address associated with the recipient identifier on the envelope, and [subtract] a cost of the postage from an account associated with an originator of the e-mail,” as recited in claim 1 would destroy the function and purpose of Itoh and render Itoh inoperable for its intended purpose because the Itoh user does not want its “subtract[ed] destination” to receive the contents of the Itoh electronic mail message, so printing it on an envelope and subtracting the cost of postage would be a waste of envelopes, time, and money for the Itoh user, especially if the “subtract[ed] destination” is the very user that is sending the electronic mail message, as previously argued above.

Thus, Itoh teaches away from “determining whether the recipient identifier in the e-mail that identifies an intended recipient of the e-mail comprises an e-mail address; in response to the determining, if the recipient identifier in the e-mail that identifies the intended recipient of the e-mail does not comprises the e-mail address, removing the recipient identifier from the e-mail, printing the e-mail, printing postage on an envelope, printing a street address associated with the recipient identifier on the envelope, and subtracting a cost of the postage from an account associated with an originator of the e-

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mail,” as recited in claim 1, and teaching away is evidence of non-obviousness and the lack of a suggestion to combine Itoh with the Schoeffler “forward[ing] on ... to a postal address” (Schoeffler at [0060]), the Maxwell “send [of] a postal mail” (Maxwell at column 8, lines 45-46), the Harris “street-address” (Harris at [0072]), and the Brookner “physical delivery of a printed document” (Brookner at column 3, lines 1-2). Thus, no suggestion or motivation exists to combine Itoh with Schoeffler, Maxwell, Harris, and Brookner, so Itoh, Schoeffler, Maxwell, Harris, and Brookner do not teach or suggest all elements of claim 1.

Claims 11 and 16 include similar elements as argued above for claim 1 and are patentable over Itoh, Schoeffler, Harris, Maxwell, and Brookner for similar reasons. Claims 2-3, 5, 12-13, and 17-18, are dependent on claims 1, 11, and 16, respectively, and are patentable over Itoh, Schoeffler, Harris, Maxwell, and Brookner for the reasons argued above, plus the elements in the claims. Claims 4, 6-10, 14-15, and 19-20 are canceled without prejudice or disclaimer, so the rejections are moot.

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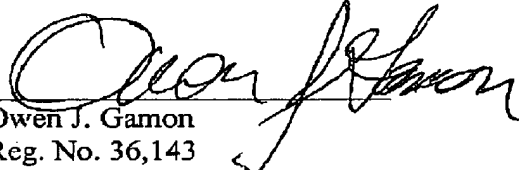
Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is requested. The Examiner is invited to telephone Applicant's attorney (651-645-7135) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 09-0465.

Respectfully submitted,

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